

REMARKS

This application pertains to a novel flame-retardant pressure-sensitive adhesive, having improved bond strength.

Claims 1-32 are pending.

Claims 1-32 stand rejected under 35 U.S.C. 112, first paragraph, as the Examiner views the recitation of “at least one” in claim 1 as allowing use of more than one ammonium polyphosphate, and the Examiner does not see where support exists in the specification or examples that would enable use of more than one ammonium polyphosphate.

The specification does, of course, provide antecedent support for “at least one” ammonium polyphosphate, at page 2, line 21.

With respect to the enablement requirement, those skilled in the art would certainly know how to use more than one ammonium polyphosphate composition.

As the Examiner knows, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation (see MPEP § 2164.01).

Does the Examiner really think that it would require undue experimentation for one

skilled in the art to determine how to add two or more ammonium polyphosphates to the flame retardant component instead of just one? This question certainly must be answered in the negative, and the rejection of claims 1-32 under 35 U.S.C. 112, first paragraph should be withdrawn.

Claims 1-4, 6-8, 10-13, 18-27, 31 and 32 stand rejected under 35 U.S.C. 102(b) as anticipated by Parsons (US 5,851,663).

In their response of August 7, 2007, Applicants explained why Parsons could not possibly anticipate the present claims. The Examiner, however, argues that the transitional phrase "comprising" recited in Applicants' claim 1 leaves the composition open to everything that is suitable for flame retardant adhesive. The Examiner further argues that the transitional phrase "consisting essentially of" which Applicants' use with reference to their flame retardant composition excludes from the composition only that which would chemically affect the composition.

The Examiner is not correct.

The transitional phrase "consisting essentially of" actually excludes materials that materially affect the basic and novel characteristics of the claimed invention. In addition, the transitional phrase "consisting essentially of" is applied to the composition of Applicants' flame retardant component. Therefore, Applicants' flame retardant includes ammonium polyphosphate and excludes any further compounds that materially affect the basic and novel characteristics of that flame retardant component.

The parsons reference discloses the use of ammonium polyphosphate only in combination with a nitrogen containing oligomer (col. 2, lines 58-59). or in admixture with a variety of other flame retardant synergists and co-agents, fillers and pigments (col. 2, lines 63-65).

Nowhere does Parsons teach or suggest that ammonium polyphosphate be used without being combined with the other named compositions. This is materially different than Applicants' invention, which does not require or permit such other flame retardant compounds.

Furthermore, Parsons does not anywhere disclose the use of ammonium polyphosphate as a flame retardant in an acrylic adhesive. Although Parsons does, as the Examiner points out, disclose acrylic adhesives, Parsons does not disclose the addition of ammonium polyphosphate and a tackifying resin to such adhesives. The Examiner has not shown where in the Parsons reference anything can be found that teaches an acrylic adhesive in combination with ammonium polyphosphate and a tackifier.

Furthermore, column 4, line s 44-46 would seem to teach away from using a tackifier with an acrylic adhesive.

Clearly, the Parsons reference does not anticipate Applicants' claims, and the rejection of claims 1-4, 6-8, 10-13, 18-27, 31 and 32 under 35 U.S.C. 102(b) as anticipated by Parsons (US 5,851,663) should be withdrawn.

Claims 1-3, 5-15, 19 and 21-29 stand rejected under 35 U.S.C.102(a or e) as anticipated by Sakurai (US 6,893,583 or US 2002/0193487) in view of evidence provided in US 6,488,958 to Himmelsbach.

Applicant's claims are drawn to a pressure-sensitive adhesive.

Sakurai discloses a curable resin composition comprising e.g. a polymerizable vinyl monomer, a polymerization initiator, a reducing agent, a flame retardant, and elastomeric component etc., and a flame retardant curable adhesive composition which consists of the curable resin composition. The curable adhesive is useful for e.g. bonding metal panels in elevators (col. 6, lines 1-4).

Nowhere, however, does Sakurai teach or suggest anything at all about a pressure-sensitive adhesive and it is quite clear that even the cured product of Sakurai's curable composition is not a pressure-sensitive adhesive.

Accordingly, there is no way that Sakurai, with or without Himmelsbach could possibly be viewed as anticipating Applicants' claims, and the rejection of claims 1-3, 5-15, 19 and 21-29 under 35 U.S.C.102(a or e) as anticipated by Sakurai (US 6,893,583

or US 2002/0193487) in view of evidence provided in US 6,488,958 to Himmelsbach should now be withdrawn.

Claims 1-32 stand rejected under 35 U.S.C. 103(a) as obvious over Parsons (US 5,851,663) or Sakuari (US 6,893,583 or US 2002/0193487) in view of Nishumura (US 2005/0227065). The Examiner cites Nishumura for a teaching of “other monomers” of acrylates, photoinitiators and specific molecular weights.

No “other monomers” of acrylates, photoinitiators or specific molecular weights could possibly overcome the differences shown above between the disclosure of the primary references and subject-matter of Applicants’ claims.

The rejection of claims 1-32 under 35 U.S.C. 103(a) as obvious over Parsons (US 5,851,663) or Sakuari (US 6,893,583 or US 2002/0193487) in view of Nishumura (US 2005/0227065) should therefore now be withdrawn.

Finally, the Examiner questions whether the molecular weight recited in claim 5 is a weight average or number average. The symbol M_w used in claim 5 will clearly convey to those skilled in the art that the molecular weight is a weight average molecular weight, as M_w is the universal symbol for weight average molecular weight.

In view of the present amendments and remarks it is believed that claims 1-32 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
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